

## **REMARKS**

This application has been reviewed in light of the Final Office Action mailed October 7, 2005. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 1, 3, 5-18, 20-21 and 23-29 are currently pending with Claims 1, 3, 6, 7, 8, 11, 16, 18, 23, 24, 25, 26, 28 and 29 being in independent form. Claims 1, 6-7, 11-15, 23-24 and 26-17 have been previously withdrawn. By the present amendment, Claims 3, 8, 9, 16, 18 and 25 have been amended. No new subject matter has been introduced by way of the present amendment.

The amendments made to Claims 3, 8, 9, 16, 18 and 25 are based on the limitations recited in previously submitted Claims 28 and 29 and thus a search of the prior art would have already been conducted regarding these limitations. Therefore, no new issues are raised by the present amendment and Applicant respectfully requests that the present amendment and remarks be entered and considered on the merits.

### **I. Rejection of Claims 3 and 25 Under 35 U.S.C. §102(e)**

Claims 3 and 25 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 5,940,761 issued to Tiedemann, Jr. et al. Claims 3 and 25 have been amended in a manner believed to place these claims in condition for allowance.

Tiedemann, Jr. et al. teaches a method for performing mobile assisted handoff between communication systems having a system preference table. However, Tiedemann, Jr. et al. does not disclose or suggest comparing a first list having at least one unique network identifier and received by a User Equipment from an active network, against a second list, internally stored in the User Equipment, which includes the at least one unique network identifier, as recited in Applicant's amended Claims.

Specifically, Claim 3 recites: “A method of facilitating handover from an active network with which User Equipment is in communication to another network, the method comprising the steps of: transmitting to the User Equipment a first list having at least one unique network identifier, comparing the first list with a second list which includes the at least one unique network identifier and is internally stored in the User Equipment for selectively communicating with at least one of a plurality of networks, the comparison being performed by the User Equipment; receiving from User Equipment communicating via the active network an indication of at least one preferred other network selected from the plurality of networks in the comparing step; and in response thereto, providing to the User Equipment via the active network neighbor cell information for the at least one preferred other network.” (Emphasis added). Claim 25 recites similar relevant limitations.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02: “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Therefore, it is not reasonably possible for Tiedemann, Jr. et al. to anticipate Applicant’s invention as recited in Claims 3 and 25, as Tiedemann, Jr. et al. fails to explicitly teach, or inherently suggest, all the claimed limitations of Applicant’s Claims 3 and 25 arranged as required by the claims. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 3 and 25 under §102(e) over Tiedemann, Jr. et al.

## II. Rejection of Claims 16-19, 28 and 29 Under 35 U.S.C. §102(e)

Claims 16-19, 28 and 29 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,223,030 issued to Van Den Heuvel et al. Claim 19 was previously canceled and thus the rejection with respect to Claim 19 is moot. Regarding Claims 28 and 29, the Examiner seems to have erroneously included Claims 28 and 29 and neglected to list Claim 20 in the preamble of the present rejection, as the arguments advanced by the Examiner in section 6 of the present Office Action only refer to Claims 16, 17, 18 and 20. Therefore, the following remarks are directed to Claims 16, 17, 18 and 20 only.

Claims 16 and 18 have been amended in a manner believed to place these claims in condition for allowance.

Van Den Heuvel et al. teaches a communications operating system for mobile phones, however Van Den Heuvel et al. does not disclose or suggest a means for performing a handover from an active network with which a mobile device is in communication to another network. Nor does Van Den Heuvel et al. disclose or suggest a means for comparing a first list received by a User Equipment from an active network, against a second list, internally stored in the User Equipment, as recited in amended Claims 16 and 18.

Specifically, Claim 16 recites: “User Equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising: means for receiving a first list from the active network, the first list having at least one unique network identifier; means for storing a second list of available other networks supplied by the active network; means for comparing the received first list with the second list which includes the at least one unique network identifier for selectively communicating with at least one of a plurality of networks; and means for transmitting from the

User Equipment an indication of a preference for a network.” (Emphasis added). Claim 18 recites similar relevant language as that highlighted in Claim 16.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02: “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Therefore, it is not reasonably possible for Van Den Heuvel et al. to anticipate Applicant’s invention as recited in Claims 16 and 18, as Van Den Heuvel et al. fails to explicitly teach, or inherently suggest, all the claimed limitations of Applicant’s Claims 16 and 18 arranged as required by the claims. Additionally, Claims 17 and 20 depend from independent Claims 16 and 18 and thus is limited by the limitations recited in those independent Claims. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 16, 17, 18 and 20 under 35 U.S.C. §102(e) over Van Den Heuvel et al.

### **III. Rejection of Claims 28 and 29 Under 35 U.S.C. §102(e)**

Claims 28 and 29 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,044,265 issued to Roach et al.

Roach et al. discloses receiving and comparing a carrier list number with a stored carrier list number. However, this carrier list number is not a list as recited in Claims 28 and 29, but rather a version number of the most current carrier list. Additionally, the received system ID (SID) is an identifier of a current network and not a list of networks. The mobile phone disclosed

in Roach et al. does not receive a list of any kind, but rather compiles a list of currently available networks by scanning the control channel for SIDs to be added to its list. (See: Roach et al. col. 4, lines 22-44).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02: “The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Therefore, as there is no comparison of a first list against a second list disclosed in Roach et al., the cited reference does not properly anticipate Applicant’s Claims 28 and 29.

Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 28 and 29 under 35 U.S.C. §102(e).

#### **IV. Rejection of Claims 5 and 8-10 Under 35 U.S.C. §103(a)**

Additionally, Claim 5 has been rejected under 35 U.S.C. §103(a) for allegedly being obvious over Tiedemann, Jr. et al. in view of U.S. Patent No. 6,272,315 issued to Chang et al., and Claims 8-10 have been rejected under 35 U.S.C. §103(a) over Van Den Heuvel et al. in view of Chang et al.

Chang et al. discloses a mobile satellite system and terrestrial wireless system interworking technique for switching a mobile unit between a mobile satellite system mode and a terrestrial wireless system mode. Additionally, Chang et al. teaches adding a system ID of a network to the bottom of a list of system Ids stored in a memory of a mobile terminal.

However, Chang et al fails to disclose or suggest subtracting a system ID from the list based on information supplied by the active network with which the User Equipment is in communication as recited in Claim 8. Further, Chang et al. fails to disclose or suggest receiving a first list having at least one unique network identifier; storing a preference for a network in a second list having the at least one unique network identifier and is internally stored in the User Equipment; comparing the received first list with the second list for selectively communicating with at least one of a plurality of networks as recited in Claims 3, 8 and 16.

Tiedemann, Jr. et al. and Chang et al., and separately, Van Den Heuvel et al. and Chang et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's invention as recited in Claims 3, 8, 16 and 25.

Claims 5 and 9-10 depend from Independent Claims 3 and 8 and thus include the limitations recited in those independent claims. Therefore, for at least the reasons given above regarding Claims 3, 16 and 25, Claims 5 and 8-10 are believed patentably distinct over the prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claim 5 under 35 U.S.C. §103(a) over Tiedemann, Jr. et al. in view of Chang et al., and the rejection with respect to Claims 8-10 under 35 U.S.C. §103(a) over Van Den Heuvel Jr. et al. in view of Chang et al.

#### **V. Rejection of Claim 21 Under 35 U.S.C. §103(a)**

Claim 21 has been rejected under 35 U.S.C. §103(a) over Van Den Heuvel et al. in view of U.S. Patent No. 6,584,116 issued to Gourgue et al. Claim 21 depends from Independent Claim 16 and thus includes the limitations recited in that independent claim.

Gourgue et al. discloses a UMTS network and a GSM network, and a method of handover to a GSM network from a UMTS network during a call originating in a UMTS

network. However, Gourgue et al. fails to overcome the deficiencies present in Van Den Heuvel et al. with respect to limitations recited by Claim 16. Specifically, Gourgue et al. fails to disclose or suggest "...means for receiving a first list from the active network, the first list having at least one unique network identifier; means for storing a second list of available other networks supplied by the active network; means for comparing the received first list with the second list which includes the at least one unique network identifier for selectively communicating with at least one of a plurality of networks..." as recited in Claim 16.


Therefore, for at least the reasons given above regarding 16, Claim 21 is believed patentably distinct over the prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claim 21 under 35 U.S.C. §103(a) over Van Den Heuvel Jr. et al. in view of Gourgue et al.

### CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 3, 5, 8-10, 16-17, 18, 20-21, 25, and 28-29 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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